The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VATSA SANTHANAM, DAVID GROSS,
and JOHN KWAN

Appeal No. 2001-2302
Application No. 09/002,404

HEARD: December 10, 2002

Before FLEMING, DIXON, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellants filed a paper on March 20, 2003 (Paper No. 21), styled "Petition to Reopen Prosecution Under CFR 1.183 and 1.198," during a period in which the instant application remained under this board's jurisdiction. We will treat the paper as a Request for Rehearing under 37 CFR § 1.197(b), requesting reconsideration of our decision entered January 23, 2003, wherein we sustained the final rejection of claims 1-4, 7-9, 12, and 15 under 35 U.S.C. § 103.

Appellants submit that our decision, in effect, constituted a new ground of rejection. We agreed with appellants, as set forth on page 4 of the prior decision, to the extent that the reference (Markstein) failed to expressly disclose that the "working precision" width is identical to the width of the floating-point registers of the associated processor. We agreed, further, there was insufficient evidence in the record to establish that proposition.

We interpreted language in claim 1 in a manner somewhat broader than the examiner's apparent reading, and pointed to teachings in Markstein that we found would have suggested floating-point data types having floating-point objects with sufficient range and precision such that the width of the memory representations of the objects fell within the range claimed by appellants.

A rejection must be considered "new" if the appellant has not had a fair opportunity to react to the thrust of the rejection. In re Kronig, 539 F.2d 1300, 1302, 190 USPQ 425, 426 (CCPA 1976). Because we disagreed with the examiner with respect to an apparent critical finding underlying the rejection, and because our interpretation of language in the instant claims was different (i.e., broader) than the examiner's apparent interpretation, we will characterize our affirmance of the rejection as a new ground of rejection under 37 CFR § 1.196(b).

Appellants point to nothing in our opinion that we consider as corresponding to any allegation of error with respect to the merits of the decision. To the extent appellants' request may be construed in any fashion as challenging the merits of the

decision, we stress that we decline to disturb our original opinion other than our grant of relief with respect a procedural matter, by deeming our affirmance a new ground of rejection under 37 CFR § 1.196(b).

We also stress that no inference relating to any ultimate conclusion of patentability or unpatentability should be drawn from our observation, on page 6 of the prior decision, that appellants have provided no evidence in rebuttal to the rejection under 35 U.S.C. § 103. We made the observation in connection with our conclusion that the evidence relied upon by the rejection was sufficient to show prima facie obviousness of the claimed invention. Any properly submitted rebuttal evidence must be considered, but submission does not automatically overcome a case for obviousness. Patentability is determined on the totality of the record, after evidence or argument is submitted by the applicant in response. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

We therefore incorporate herein our earlier decision, but characterize our affirmance of the rejection as a new ground of rejection under 37 CFR § 1.196(b). We hereby designate this decision to be, in effect, a new decision.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, “A new ground of rejection shall not be considered final for purposes of judicial review.”

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claim:

> (1) Submit an appropriate amendment of the claim so rejected or a showing of facts relating to the claim so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner
> . . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

GRANTED-IN-PART

MICHAEL R. FLEMING Administrative Patent Judge	)
	) BOARD OF PATENT
JOSEPH L. DIXON Administrative Patent Judge	) APPEALS) AND) INTERFERENCES
HOWARD B. BLANKENSHIP Administrative Patent Judge	)

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